

REMARKS***AMENDMENTS TO THE SPECIFICATION***

The Applicants have amended the title in accordance with 37 C.F.R. § 1.72 such that it is as short and specific as possible. Specifically, the title now refers to message classification utilizing acceptable items as is found in each and every one of the independent claims. See MPEP § 606.

The Applicants have added a *Summary of the Invention* section in accordance with 37 C.F.R. § 1.73 that is "commensurate with the invention as claimed." See MPEP § 608.01. As the claims are fully supported by the specification and the newly added *Summary of the Invention* is commensurate with those claims, the Applicants contend no new matter is added to the present application.

AMENDMENTS TO THE CLAIMS

Claims 1-21 were presented for examination. Claims 2, 8, 9, 12, 15, and 16 are cancelled through the present amendment. Claims 22-24 are new and added through the present amendment. All claims originally presented and not cancelled have been amended herewith.

REJECTIONS UNDER 35 U.S.C. § 101

The Examiner contends that the claims as previously presented for examination were "rejected under 35 U.S.C. 101" as being "directed to non-statutory subject matter." *Office Action*, 2. "Specifically," per the Examiner, "the claimed invention does not appear to produce a useful, concrete and tangible result" that "make[s] available for use the result of the determination." *Office Action*, 2. Further, the Examiner contends that "the asserted practical application . . . [of] 'classifying electronic messages'" "is not explicitly recited in the claim." *Office Action*, 2.

The Applicants have amended the independent claims of the present application to recite, *inter alia*, 'a method for classifying a message,' including the steps of 'classifying the message based on whether [a] canonical equivalent of each of the items [of a certain type] are determined to meet a criterion' and 'processing the message in accordance with the classification of the message.' The Applicants believe that by processing the message in accordance with a determined classification that the claims now recite a 'useful, concrete, and tangible result' that avails itself of the aforementioned determination. Further, the Applicants have better highlighted the practical application of electronic message classification. As such, the Applicants believe that the Examiner's 35 U.S.C. § 101 rejection has been overcome.

REJECTIONS UNDER 35 U.S.C. § 102(E)

The Examiner has rejected independent claims 1, 20, and 21 "under 35 U.S.C. 102(e) as being anticipated by [U.S. patent number 7,149,778 to] Patel et al." *Office Action*, 3. The Applicants have amended the independent claims of the present application to recite (a) 'reducing each of the all items of a certain type to a canonical equivalent that identifies a group of synonymous words or phrases'; (b) 'determining whether the canonical equivalent of each of the items of a certain type meets a criterion, the criterion corresponding to an acceptable item'; and (c) 'classifying the message based on whether the canonical equivalent of each of the items of a certain type are determined to meet the criterion.' The Applicants believe that Patel fails to anticipate the independent claims as amended.

The Applicants note that the Examiner stated, with respect to original claim 10, that "Patel does not explicitly teach determining whether each of the items meets a criterion includes reducing the item to its canonical equivalent." *Office Action*, 8. With respect to this particular limitation, the Examiner referred to U.S. patent publication number 2003-0041280 to Malcolm et al. See *Office Action*, 8. The Examiner contends that this particular element is disclosed at paragraph [0070] of the Malcolm reference. Regardless of whether this particular element is disclosed by Malcolm, the Applicants respectfully traverse the Examiner's assertion that "[i]t would have been obvious to one of ordinary skill in the art . . . to modify the teachings of Patel to reduce the item to its canonical equivalent . . . as taught by Malcolm" in order to "maximize efficiency of the system." *Office Action*, 9 (citing Malcolm at [0010]).

As noted in [0003], Malcolm "relates to devices for caching objects transmitted using a computer network." Malcolm utilizes a cache engine "to maximize efficiency" and to "atomically commit changes to disk during each write episode, so the cache engine does not fail in response to loss power or storage, or other intermediate failure of portions of the cache." Malcolm does so with respect to seeking to address problems related to "delay or restricted functionality from having to use a local operating system and local file system or file server." Malcolm, [0008]. There is no suggestion that the caching taught by Malcolm (regardless of the use of a canonical equivalent) has any applicability and/or relevance with respect to the classification of electronic mail.

A generalized statement of 'maximized efficiency' fails to establish the requisite motivation to combine as required by a *prima facie* case of obviousness. See *In re Vaack*, 947 F.3d 488 (Fed. Cir. 1991); see also MPEP § 2142. For example, an improved carburetor may result in maximized efficiency of engine performance. The Applicants doubt that such an assertion of maximized efficiency with respect to a car engine would receive serious consideration as meeting the aforementioned *prima facie* standard in the context of electronic-mail classification.

The Applicants assert that such logic is equally applicable to the present case. The mere recitation of 'maximized efficiency' does not create a nexus between Malcolm and Patel with respect to the requisite motivation to combine. As noted by the Board of Patent Appeals in the matter of *Ex parte Clapp*, "the references . . . or the examiner must present a convincing line of reasoning as to why [an] artisan [of ordinary skill in the relevant art] would have found the claimed invention to have been obvious in light of the teachings of the references." 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). The Applicants respectfully contend a suggestion from the references and the Examiner are both lacking with respect to the present rejection.

A canonical equivalent is now set forth in each of the independent claims. The Examiner admits that this aspect is lacking from Patel. As discussed above, there is no motivation to combine Patel and Malcolm—the latter reference being relied upon by the Examiner to evidence a canonical equivalent. Absent a canonical equivalent in Patel and the lack of a motivation to combine Patel with Malcolm, the Applicants contend that the independent claims of the present application are novel and non-obvious over the cited art of record and the 35 U.S.C. § 102(e) rejection is overcome.

CONCLUSION

The Applicants have amended the specification and claims. No new matter is added through these amendments.

The Applicants have amended the claims to reflect a useful, concrete, and tangible result. As such, the Applicants contend that the Examiner's 35 U.S.C. § 101 rejection is overcome.

The Examiner has admitted Patel fails to disclose a canonical equivalent. As each of the independent claims recites a canonical equivalent, the Applicants contend the Examiner's 35 U.S.C. § 102(e) rejection is overcome.

To the extent that Malcolm discloses a canonical equivalent, the Applicants contend that there is no motivation to combine Patel with Malcolm. As such, any rejection of the independent claims under 35 U.S.C. § 103(a) is preemptively overcome.

Any claim dependent upon one of the aforementioned independent claims—either directly or via an intermediate dependent claim—is allowable for at least the same reasons as the claim from which it depends. As such, each and every one of the dependent claims of the present application are also in condition for allowance.

As all rejections have been overcome, the Applicants contend the present application is in condition for allowance.

The Examiner is invited to contact the Applicants' undersigned representative with any questions concerning the present amendment.

Respectfully submitted,
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